

REMARKS

The Applicant thanks the Examiner for indicating that claims 9-12 are allowed while claims 2 and 8 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claim(s). In accordance with this indication, claim 8 is appropriately revised to be an independent claim, and that amended independent claim, along with claims 9-12, are now believed to be allowable.

Claims 1 and 3-7 are rejected, under 35 U.S.C. § 103, as being unpatentable over Thumann '244 in view of Levy et al. '492 and Lacoste et al. '583. The Applicant acknowledges and respectfully traverses the raised obviousness rejection in view of the following remarks.

Thumann '244 teaches a retractable covering for a door opening comprising a housing 24, a screen 28, a latching strip 26 and a side member 100. The screen 28 can be pulled from the housing 24 by the side member 100 and extended across the width of the door opening. The latching member 100 is then attached to a V-shaped channel 120 to retain the screen 28 in an extended position across the width of the door opening, in essence, to act as a screen door (see Fig. 2 of Thumann '244). This retractable covering is meant to eliminate a conventional hinged screen door (see col. 2, Ins. 56-57) and, it is respectfully submitted, that the screen 28 is not of a flexible sheet material able to withstand a plurality of repeated impacts from projectiles, selected from one or more of a hockey puck, a golf ball, a football, a soccer ball, a baseball, and a softball, as presently recited.

Levy et al. '492 describes a process of making a decorative stained glass effect window shade. The process generally includes making an actual stained glass window; next, taking a picture of the stained glass window on a transparency film; preparing a printing roller from the transparency film of the stained glass window. Next, printing the window reproduction on to a transparent plastic film. Finally, the transparent film is hung in a window to give the illusion of having a stained glass window. It is respectfully submitted that this reference is not particularly relevant to the art of covering a doorway with a screen 28, as disclosed by Thumann '244.

Moreover, it is respectfully submitted that the screen 28 of Thumann '244 does not appear to have a sufficient surface area to enable at least one graphic of a sport practice target to be visibly placed thereon, let alone to be placed on opposite sides thereof, as presently recited.

Lacoste et al. '583 teaches a door opening screening system. This system includes a pair of retractable screen assemblies 34. When in a retracted position the two assemblies 34 are each housed in a housing 22. During use, the assemblies 34 extend toward and meet with one another in the middle of the opening where rigid vertical supports 38 of the two assemblies 34 meet and are connected together.

The Applicant respectfully asserts that there is no suggestion or motivation, either in the applied references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the applied references or to combined the teachings of the applied references with one another as alleged by the Examiner. As the Examiner is well aware to support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention have been obvious in light of the teaching of the references. It is respectfully submitted that the Examiner has not complied with his burden.

As stated in the original appeal decision concerning this application, the Board of Patent Appeals and Interferences (BPAI), in November of 2003, stated "the mere fact that the prior art could be modified as proposed by the Examiner is not sufficient to establish a prima facie case of obviousness". The Applicant asserts that the cited prior art fails to provide any suggestion or motivation to combine or modify these references in a way so as to render the currently claimed subject matter obvious. In fact, the Applicant asserts, as commented on by the BPAI in the above referenced appeal, the Examiner does not direct us to any motivation or suggestion in the applied references for employing the retractable covering described by Thumann '244 or the door screening system of Lacoste et al. '583 as a target for projectiles, as currently claimed.

The Applicant reminds the Examiner that when rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073-74, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion, or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

As noted above, the Applicant asserts that the Examiner has failed to establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied prior art references. The Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the Applicant. *Id.* Further, "[a] prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art". In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA) 1976)). If the Examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

If the Examiner maintains that there is still an explicit or implicit teaching or suggestion in the prior art, he/she must indicate where such teaching or suggestion appears in the applied references. *In re Yates*, 663 F.2d 1054, 211 USPQ 1149, 1151 (CCPA 1981). "The mere fact that a certain thing may result from a given set of circumstances is not sufficient [to establish inherency]". *In re Ulric*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981) (citations omitted). "That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown." *In re Sporrin*, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966). Such a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection. See *In re Newel*, 891 F.2d 899, 901, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989). "In order to justify a combination of references such as is here suggested it is necessary not only that it be physically possible to combine them, but that the art should contain something to suggest the desirability of doing so." *Ex Parte Walker*, 135 USPQ 195, 196 (Patent Office Board of Appeals 1962).

Lastly, it is the Examiner's position that the limitations of claim 1 relating to repeated impacts from projectiles are obvious, as it only requires two such impacts. It is also the Examiner's position that impacting the screen with a ping pong ball meets the limitations and that the references cited could withstand such an impact. In the event that an Appeal is necessary, it appears to the Applicant that the current outstanding issues are very similar to those addressed in the original appeal which was addressed in the Decision mailed November 2003. However, the Applicant has considered the comments made by the Examiner in the official action and is advancing amendments which, it is hoped, will directly address the concerns expressed by the Examiner and lead to an allowance of the Application.

Relating to the claim language of "repeated impacts" and the Examiner's assertion that such language covers "two such impacts", the claim 1 is amended and now recites "a plurality of repeated impacts". Further, with respect to the type of projectiles the material must be able to withstand, a list of projectiles has reluctantly been added to the language of the claim, namely, a projectile selected from one or more of a hockey puck, a golf ball, a football, a soccer ball, a baseball, and a softball.

In view of the foregoing arguments, it is respectfully submitted that the present application is now in a condition for allowance. The Applicant, therefore, requests the early issue of a Notice of Allowance.

However, if any further amendment to this application is believed necessary to advance prosecution and place this case in allowable form, the Examiner is courteously solicited to contact the undersigned representative of the Applicant to discuss the same.

In view of the above amendments and remarks, it is respectfully submitted that all of the raised rejection(s) should be withdrawn at this time. If the Examiner disagrees with the Applicant's view concerning the withdrawal of the outstanding rejection(s) or applicability of the Thumann '244, Levy et al. '492 and Lacoste et al. '583 references, the Applicant respectfully requests the Examiner to indicate the specific passage or passages, or the drawing or drawings, which contain the necessary teaching, suggestion and/or disclosure required by case law. As such teaching, suggestion and/or disclosure is not present in the applied references, the raised rejection should be withdrawn at this time. Alternatively, if the Examiner is relying on his/her expertise in this field, the Applicant respectfully requests the Examiner to enter an affidavit substantiating the Examiner's position so that suitable contradictory evidence can be entered in this case by the Applicant.

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In view of the foregoing, it is respectfully submitted that the raised rejection(s) should be withdrawn and this application is now placed in a condition for allowance. Action to that end, in the form of an early Notice of Allowance, is courteously solicited by the Applicant at this time.

In the event that there are any fee deficiencies or additional fees are payable, please charge the same or credit any overpayment to our Deposit Account (Account No. 04-0213).

Respectfully submitted,



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